

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 2 and 11-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10 August 2005.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 6-10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Erskine (US 5,501,675).

Claims 6 and 14: Erskine teaches (**Fig 1-3**) a medical device comprising:

A hollow housing (30); a needle (32); a catheter (20) with hub (22); a biasing element (39); a needle retainer (34) operable between a latched (pushed away from the housing, Fig 2) and unlatched (pushed into the housing, Fig 3) position, comprising a radially deflecting elongated arm (40) which directly engages the catheter hub (22, Fig 2); and an exposed surface (push surface 34) to delay retraction of the needle (by maintaining the latch in the "up" position, such as by pulling on the latch).

Claim 7: the outside of the latch (40) includes a step portion (see Fig 3) which abuts the exterior (rear surface) of the catheter hub (Fig 2).

Claim 8: housing 30 is a fluid chamber

Claim 9, 10: Fig 2

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw et al (US 5,989,220) in view of Sircom (US 5,458,658).

Shaw teaches (Fig 1-4) a medical device comprising: a housing (14) a needle (60); a catheter (22) with hub (24); a biasing element (16); a needle retainer (56) fixedly connected with the needle (Fig 2) comprising an arm (58) which engages the catheter (at 34) to retain the needle against the biasing force. See also flash chamber (74)

Shaw does not teach that the arm is radially deflecting; instead it holds the catheter and needle with a frictional force.

Sircom teaches a radially deflecting arm (608,609) for retaining a catheter (601) with hub (602) to retractable needle (603). Fig 1 and 6.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the deflecting arm of Sircom instead of the frictional engagement of Shaw because the deflecting arm is more reliable than the frictional engagement. For example, the frictional engagement could be weakened by fluids (blood, medicine, saline, or antiseptic) between the surfaces which would not affect the arm-latch of Sircom.

### ***Response to Arguments***

5. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Terminal Disclaimer***

6. The terminal disclaimer filed on 7 May 2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 6,436,070 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELIZABETH R. MACNEILL whose telephone number is (571)272-9970. The examiner can normally be reached on 9:00-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Simons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elizabeth R MacNeill/

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Examiner, Art Unit 3767

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Supervisory Patent Examiner, Art Unit 3767